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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/685,850
Filing Date: October 10, 2000
Appellant(s): PEFFLY ET AL.

MAILED
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GROUP 2900

Laura L. Frieko
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/12/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellants state in the brief that claims 1-46, 53-69 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

US 4,940,578	Yoshihara et al.	7-1990
US 5,325,878	McKay	7-1994
US 5,565,207	Kashibuchi et al.	10-1996
US 5,002,075	Kellett et al.	3-1991

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(10) Grounds of Rejection and (11) Response to Arguments

The following ground(s) of rejection are applicable to the appealed claims:

Applicants claim a scalp cosmetic composition comprising:

- i) from about 40% to about 99% by weight of a volatile liquid having a vapor pressure greater than 23.7 mmHg as measured at 25 deg. C,
- ii) from about 0.005% to about 20% by weight of a skin active agent, and
- iii) from about 0.1% to about 20% by weight of a liquid humectant, wherein the composition is a leave-on composition that is substantially free of cleaning surfactants and is applied directly to the scalp.

Issue #1

Claims 1-12, 15-18, 21-32, 35-38, 53-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578).

The prior art Yoshihara discloses a hair preparation comprising an oil-absorptive substance and an anti-dandruff agent. See Abstract. The base of the hair preparation is a mixture of water and ethanol. The most preferred base of the hair preparation is mixture of water and ethanol in a weight ratio of 99/1 to 20/80. See col. 6 lines 20-26. Applicants disclose ethanol as a volatile liquid having a vapor pressure greater than 23.7 mmHg as measured at 25 deg. C. The anti-dandruff agent is zinc pyrithione. See col. 8 and Examples. The hair preparation comprises 0.01 to 10 percent by weight of an anti-dandruff agent. The hair preparation may also contain other ordinary components in such amounts that they do not

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damage the effect of the preparation. The components include surfactants, humectants, and vitamins. Specific humectants disclosed include glycerol (glycerin) and dipropylene glycol. See col. 6 lines 36-46 and col. 10 lines 54-58. The composition is applied to the scalp after shampooing and drying the scalp with a towel. See Examples. While Yoshihara discloses all the elements of the instant claims, Yoshihara does not disclose all the elements in a single example.

It is the position of the examiner that it would be obvious to one of ordinary skill in this art, at the time of invention, by routine experimentation, to combine the elements taught by the reference into one composition, determining the preferred amount of each component as desired by Applicant to achieve the desired results of providing a cosmetic composition with a moisturizer or humectant. The reference desires a cosmetic composition comprising an anti-dandruff agent, a carrier, and other components. The expected result would be a cosmetic composition comprising ethanol, zinc pyrithione and a humectant, specifically glycerol (glycerin).

Response to Arguments: Rejection under 103(a) over Yoshihara et al.

Applicants argue the rejection should be withdrawn because Applicants have shown unexpected results.

Declaration under 37 CFR 1.132

The Declaration of Marjorie Mossman Peffly filed under 37 CFR 1.132 has been considered but does not overcome the rejections. The examiner does not see any unexpected nature of the results from the data presented in the Declaration. Furthermore, the scope of the claims is broader than that of the results presented in the declaration in terms of 1) generic volatile

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liquid and its upper limit 99% by weight and 2) that of the generic liquid humectant and its lower limit of 0.1% with regard to 1). Instant claim 1 recites 99% as the upper limit for the volatile liquid and it is known that ethanol is a delipidizing agent and at this level of ethanol, Applicant has not shown that 0.1% of glycerol would moisturize the skin.

Furthermore, the scope of the claims is broader than the scope of the Declaration. The Declaration is limited to 5% glycerin. The claims are not limited by glycerin or by 5% of glycerin. The instant claims also have "further comprising" ingredients.

While the examiner has argued the scope of the claims is broader than the scope of the Declaration, the Applicants argue the Declaration is commensurate in scope. Applicants refer to MPEP 716.02(d), stating the nonobviousness of a broader claim can be supported by evidence based on unexpected results from testing a narrower range in one of ordinary skill in the art would be able to determine a trend in the exemplified data that would allow the artisan to reasonably extend the probative value thereof. The examiner refers to Yoshihara wherein humectants, such as glycerol (glycerin), are disclosed. Humectants are known in the art and therefore one of ordinary skill in the art would determine a suitable amount of humectant in order to achieve moisturizing the scalp and hair. Therefore, the claim is obvious in view of the prior art.

It is the position of the examiner it would have been obvious to one of ordinary skill in the art at the time the invention was made to "add other ordinary components", (as suggested by Yoshihara) such as humectants, specifically glycerol (glycerin) or dipropylene glycol to the scalp treatment in order to provide a moisturizing effect. Humectants, by definition, are substances

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that promote retention of moisture. Therefore, by adding humectants, as suggested by Yoshihara, moisturizing of the scalp would be obtained.

Issue #2

Claims 13, 19, 20, 33, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashibuchi et al. (US 5565207).

Kashibuchi discloses a cosmetic moisturizer comprising an active ingredient. See abstract. The moisturizer may contain additional active ingredients such as zinc pyrithione, menthols, surfactants, allantoin, and vitamin E. Humectants and alcohols may also be included. See col. 6, lines 1-58. The cosmetic moisturizer may take different forms, for example, scalp essences, shampoos and tonics. See col. 6, lines 59-61. Kashibuchi discloses the following tests: A) test for recovery of regularity of cellular arrangement of scalp corneocytes and for the improvement in multi-layer desquamation; B) visual observation of scalp lesions and C) test for hair moisturizing effect. Kashibuchi does not teach the composition to be in an applicator. While Kashibuchi discloses all the elements of the instant claims, Kashibuchi does not disclose all the elements in a single example.

It is the position of the examiner that it would be obvious to one of ordinary skill in this art, at the time of invention, by routine experimentation, to combine the elements taught by the reference into one composition, determining the preferred amount of each component as desired by applicant to achieve the desired results. The reference desires a cosmetic composition comprising an allantoin, vitamin E and menthol and alcohols. The expected result would be a composition comprising an active ingredient to be applied to the scalp.

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Response to Arguments: Rejection under 103(a) over Kashibuchi et al.

Applicants argue Kashibuchi et al. does not teach a volatile liquid in combination with a humectant and skin active agent and Kashibuchi teaches away from the use of large amount of humectants. However, the examiner refers to the teaching of Kashibuchi at col. 6 lines 10-16, 48-57 where other ingredients such as alcohols, which includes ethanol, may be incorporated into the cosmetic moisturizer. Also, at col. 6 lines 45-47, humectants may also be incorporated into the cosmetic moisturizer. Applicant is claiming the amount of humectant be from about .01% to 20%, more preferably from about 1% to about 10%. Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention to use a lower amount of humectant, as desired by the reference and applicant, in order to achieve the desired results of moisturizing as claimed by Applicant. Kashibuchi et al. specifically describes in the examples the effects of both the hair and scalp. Therefore the composition is applicable to both as a moisturizer.

Furthermore, the Declaration is not commensurate in scope with the claims. Applicants have not established a correlation with the claims. The claims are not reasonably related to formulations in the Declaration. Neither the specific additive (moisturizer) nor the amount has been claimed. The amount of the additive has not been established as being no more than the conventional amounts suggested by Kashibuchi et al.

Issue #3

Claims 14, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578) and further in view of McKay (US 5325878).

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Yoshihara, as disclosed above, teaches a cosmetic composition. Yoshihara does not teach the composition be contained in an applicator.

McKay is relied on for the teaching of a applicator, specifically a fluid dispensing comb. The fluid dispensing comb has a body upon which a plurality of teeth are formed such that they are configured to have a V-shape, thereby defining a groove. An absorbent pad is disposed within the groove defined by the teeth and functions as a reservoir and application means for containing and dispensing a fluid. Thus, the dispensing comb provides a simple and convenient means for applying fluids to the hair whereby the user avoids directly contacting the fluid with the hands. See Abstract.

It would be obvious to one of ordinary skill in this art at the time of invention to modify the teaching of Yoshihara to use the teachings of McKay with regard to using a fluid dispensing comb to apply a composition to the scalp because McKay teaches the dispensing comb provides a simple and convenient means for applying fluids to the hair whereby the user avoids directly contacting the fluid with the hands. Both Yoshihara and McKay desire the composition to be applied to the hair and scalp. The expected result would be an applicator comprising a cosmetic composition.

Response to Arguments: Rejection under 103(a) over Yoshihara in view of McKay et al.

Applicants argue the instant claims are drawn to the composition being applied directly to the scalp while the prior art applies the composition indirectly to the scalp.

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to use the teachings of McKay with regard to using an applicator to apply a composition to the scalp in the teachings of Yoshihara because McKay

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teaches a hair composition as in Yoshihara. Both Yoshihara and McKay desire the composition to be applied to the hair and scalp. The expected result would be an applicator comprising a cosmetic composition. Therefore, the rejection should be maintained.

Applicants also argue the comb of McKay would unduly affect hair cosmetics. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicator not unduly affecting hair cosmetics) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the future intended mechanism of application does not impart patentable feature to a composition.

It is axiomatic that a prior art reference does not have to disclose each and every feature that is well known in the prior art. It is well known that lotions, gels, shampoos, creams and ointments disclosed by the prior art require storage in a container/applicators. Fluids take the shape of their container since they do not have a definite shape. One of ordinary skill in this art at the time of the invention envisions the necessity for a container/applicators when fluids are involved. Applicants' use of the word "applicator" must be given its broadest interpretation when present before an examiner, consistent with the scope permitted by the specification. In any event, the secondary reference establishes a suitable and effective applicator within the scope of the claim limitations. The position taken is the obviousness of the formation of a applicator containing an equivalent formulation. How the formulation is future administered is not the issue.

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Issue #4

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. (US 4940578) and McKay and in further in view of Kellett et al. (US 5002075).

Yoshihara, as disclosed above, teaches a cosmetic composition. McKay as disclosed above, teaches a fluid-dispensing comb to apply a composition. Yoshihara and McKay do not teach an insecticidal agent in the composition.

Kellett is relied on for the teaching of an applicator comprising a matrix comprising a hair-conditioning agent and a nonionic surfactant. See Abstract. Minor but effective amount of agents which can control or eliminate fleas, ticks and other pests when applied topically to the hair of the animal, such as a dog or cat, can also be incorporated into the pad-comb composites. Such agents include organophosphorus compounds such as carbamates, as well as methoxychlor, rotenone and the pyrethrins. See col.13, lines 41-1.

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to use the teachings of Kellett with regard to using an insecticidal agent in a cosmetic composition in the teachings of Yoshihara and McKay because Kellett teaches a hair composition applied with an applicator as in Yoshihara and McKay. The expected result would be an applicator comprising a cosmetic composition for treating fleas and ticks.

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Response to Arguments: Rejection under 103 (a) over Yoshihara et al. in view of McKay and Kellett et al.

Applicants argue the instant claims are drawn to the composition being applied directly to the scalp while the prior art applies the composition indirectly to the scalp.

It is the position of the examiner that it would have been obvious to one of ordinary skill in this art at the time of invention to use the teachings of McKay with regard to using an applicator to apply a composition to the scalp in the teachings of Yoshihara because McKay teaches a hair composition as in Yoshihara. All prior art references desire the composition to be applied to the hair and scalp. The expected result would be an applicator comprising a cosmetic composition.

Applicants also argue the comb of McKay would unduly affect hair cosmetics. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicator not unduly affecting hair cosmetics) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the future intended mechanism of application does not impart patentable feature to a composition.


It is axiomatic that a prior art reference does not have to disclose each and every feature that is well known in the prior art. It is well known that lotions, gels, shampoos, creams and ointments disclosed by the prior art require storage in a container/applicators. Fluids take the shape of their container since they do not have a definite shape. One of ordinary skill in this art

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at the time of the invention envisions the necessity for a container/applicators when fluids are involved. Applicants' use of the word "applicator" must be given its broadest interpretation when present before an examiner, consistent with the scope permitted by the specification. In any event, the secondary reference establishes a suitable and effective applicator within the scope of the claim limitations. The position taken is the obviousness of the formation of an applicator containing an equivalent formulation. How the formulation is future administered is not the issue.

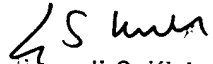
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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May 15, 2003

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